

### REMARKS

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1-48 remain pending. Claims 1, 6, 11, 13, 15, 17, 19, 21, 23, and 26 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

#### ***Claim Rejections - 35 U.S.C. §103(a)***

Claims 1, 5-6, and 10-48 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,542,936 to Mayle et al. ("Mayle") in view of U.S. Patent No. 7,062,454 to Giannini et al. ("Giannini"), and further in view of Ho-Ka-Go! English Homepage ("Ho-Ka-Go!"). Claims 2-4 and 7-9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mayle, Giannini, and Ho-Ka-Go! and further in view of U.S. Patent No. 6,583,799 to Manolis et al. ("Manolis"). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejection.

For a 35 U.S.C. § 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

Independent **claim 1** recites, *inter alia*, a method of reading a user image and a plurality of templates each having an image insertion area for inserting the user image therein; inserting the user image in the image insertion area of each of the templates and generating a catalog of the templates each having the user image therein; and concurrently displaying a plurality of the templates of the catalog and the user image, **wherein each template within the catalog has a unique layout of its respective image insertion area within the template**. Applicants submit that the cited references, alone or in combination, do not teach or suggest the method as claimed.

Mayle is directed to a system for creating a message including a user image, otherwise referred to as an "electronic postcard". A Web-based interface is provided

wherein a user may enter data into a blank postcard. The respective areas of the postcard (user image, address text, message text, etc.) are initially blank. *See col. 8, lines 11-20.* Tabs are provided such that a user may access the respective areas of the postcard and enter information, including a user-selected photo. *See col. 8, lines 22-34, Figures 6-17.* Mayle states that when a user clicks on a tab a new web page appears that contains a form with input fields for the selected part of the card. *See col. 8, lines 29-31.* The Examiner has indicated that he is interpreting the web page for each tab as being a separate template, and that the user image is inserted into each of the templates in the area designated for the user-provided image on the postcard. *See Office Action, pages 2-3.*

In the Office Action, the Examiner concedes that Mayle fails to disclose generating a catalog of the templates each with the user image inserted therein, and displaying a plurality of the templates of the catalog. The Examiner relies on Giannini to cure this deficiency, stating that Giannini teaches displaying user submitted images “inserted in a background template image” and “displayed as a form of catalog.” The Examiner refers to Figure 16 as showing this feature. According to the Examiner, based on the disclosure of Giannini, it would have been obvious to display the templates of Mayle “concurrently to a user for more concise inspection and customization.” Applicants traverse and respectfully submit that there is no logical basis for displaying the templates of Mayle in such a manner.

The Examiner expressly states that he interprets the templates of Mayle as being the individual web pages accessed by the tabs on the postcard interface. The purpose of the tabs is such that a user can individually select various portions of the postcard for data entry such that only the selected area is customizable at a given time. Displaying all of the templates at once would hinder expeditious entry of the data into the electronic postcard and generally result in a cluttered and redundant display. In fact, Mayle expressly *teaches away* from showing all of the data entry fields all at once, let alone displaying at the same time all of the individual web pages associated with each of the tabs. Applicants respectfully submit that there is no reason to display all of the templates in such a manner, nor would one of ordinary skill in the art find it obvious or beneficial to do so based on the alleged teachings of Giannini.

Applicants note that although Mayle makes mention of a “Baby Journal” or “Family Album” (which the Examiner considers to be a “catalog”), no disclosure is given about how the electronic postcard creation system described in the rest of the patent is intended to be modified for such an application. Mayle does not disclose displaying a user image in a plurality of templates as parts of a journal or family album. *See col. 13, line 51 – col. 14, line 11.*

Furthermore, Applicants note that claim 1 as amended recites wherein each template within the catalog has a unique layout of its respective image insertion area within the template. The web pages of Mayle (interpreted as templates by the Examiner) all have the same layout for the user image inserted into the postcard. Therefore, Mayle cannot teach the above feature of the claim. Giannini may teach displaying a plurality of pictures at once (see Figure 16), but cannot teach that each image is inserted into a template having a unique layout of its respective image insertion area within the template. Indeed, all of the image insertion areas for photos 282 appear to have the same layout.

The Examiner further relies upon Ho-Ka-Go! to teach unique templates. However, although Ho-Ka-Go! may concurrently display a plurality of selectable frames (see Figure 5), these frames are not the same as templates each having a unique layout for the respective image insertion areas within the template. Indeed, the image insertion areas of Ho-Ka-Go! have the same shape and are not unique in respective layouts *within a template*. Furthermore, Ho-Ka-Go! fails to teach wherein the user image is inserted into the template and a plurality of templates are displayed as a catalog.

In this instance, the combination of Mayle, Giannini and Ho-Ka-Go! fails to teach or suggest each and every limitation of claim 1. As demonstrated above, the prior art fails to teach or suggest the feature “wherein each template within the catalog has a unique layout of its respective image insertion area within the template” as recited in claim 1. Therefore, claim 1 is distinguishable from the prior art. Applicants hereby apply the above reasoning to independent claims 11, 15, 21, and 23, which have been amended in a similar fashion and are therefore also distinguishable from the prior art. Dependent claims 2-5, 12, 16, 22, 24, 25, 29, 30, 33, 34, 37, 38, and 43-46 are also distinguishable from the prior art at least due to their dependence from claims 1, 11, 15, 21, and 23, directly or indirectly.

Therefore, Applicants submit that claims 1-5, 11, 12, 15, 16, 21-25, 29, 30, 33, 34, 37, 38, and 43-46 are patentable over the prior art and respectfully request that the rejection of these claims under §103(a) be withdrawn.

Independent **claim 6** recites, *inter alia*, a method comprising: reading a plurality of user images and a template having an image insertion area for inserting the user images therein; generating templates having the user images therein by inserting the respective user images in the image insertion area of the template while generating a catalog of the templates having the user images; and concurrently displaying a plurality of the templates of the catalog and the plurality of user images, wherein each template of the catalog has a different user image inserted therein from other templates of the catalog.

The Examiner in rejecting claim 6, states “claim 6 incorporates substantially similar subject matter as claimed in claim 1, and ... is rejected along the same rationale,” and further states that “Mayle teaches a plurality of user images available for use (Mayle Figure 10).” *See Office Action, page 4.* Applicants respectfully traverse the Examiner’s characterization of claim 6 and further submit that the Examiner has failed to present a *prima facie* case of obviousness for claim 6.

First, claim 6 is directed to a method whereby a plurality of *different* user images are inserted into templates having image insertion areas. A catalog of the templates having the user images is generated and a plurality of the templates of the catalog are concurrently displayed. In contrast, Mayle merely teaches that a plurality of user images are available. Figure 10 shows that a user may select a user image from multiple images to use as the postcard image. However, this is not the same as inserting a plurality of different images into the previously discussed templates (corresponding to the selection tabs). In fact, Mayle makes no mention of concurrently displaying different images inserted into templates displayed within a catalog. Regarding the other prior art, Giannini teaches displaying the *same* user image in multiple composite images (see Figure 16). Ho-Ka-Go! also fails to teach displaying multiple different images in any fashion.

In this instance, the combination of Mayle, Giannini and Ho-Ka-Go! fails to teach or suggest each and every limitation of claim 6. Therefore, claim 6 is distinguishable from the prior art. Applicants hereby apply the above reasoning to independent claims 13, 17, 19, and 26, which are likewise distinguishable from the prior art. Dependent

claims 7-10, 14, 18, 20, 27, 28, 31, 32, 35, 36, 39-42, 47, and 48 are also distinguishable from the prior art at least due to their dependence from claims 6, 13, 17, 19, and 26 directly or indirectly.

Therefore, Applicants submit that claims 6-10, 13, 14, 17-20, 26-28, 31, 32, 35, 36, 39-42, 47, and 48 are patentable over the prior art and respectfully request that the rejection of these claims under §103(a) be withdrawn.

### CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact John R. Sanders (Reg. No. 60,166), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Due Date: September 5, 2007

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: 

D. Richard Anderson

Reg. No. 40,439

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

Attorney for Applicant

DRA/JRS/khm

JRS